

BEST AVAILABLE COPY**REMARKS**

Applicant has carefully studied the Office Action of August 13, 2004, and offers the following remarks to accompany the above amendments.

Applicant herein amends claims 1, 17, 21, 26, and 27 to recite that the remote location is a fueling site. Applicant further amends claims 2 and 21 to recite that the software upgrade is an executable software upgrade. Applicant also amends claim 21 to recite that the computer at the remote location is a site controller. Claim 17 is also amended to include a sentence ending period, which appears to have been inadvertently omitted heretofore. Claims 5, 11, 13, and 29 are amended to conform to the independent claims. Claim 30 is amended to correct antecedent basis and to fix a typographical error.

Rejection Under 35 U.S.C. § 102(e) -- Rajakarunananayake

Claims 1, 3, 5-7, and 10 were rejected under 35 U.S.C. § 102(e) as being anticipated by Rajakarunananayake et al. (hereinafter "Rajakarunananayake"). Applicant respectfully traverses. For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131.

Applicant has amended claim 1 to include the original subject matter of claim 2. As such, this amendment moots the § 102(e) rejection. Applicant requests withdrawal of the § 102(e) rejection at this time.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunananayake & Finley

Claims 2, 4, 11, and 30-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunananayake and Finley et al. (hereinafter "Finley"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references. Second, the Patent Office must support the motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, the Patent Office must still show where each and every element of the claim is located in the combination of references. MPEP § 2143.03.

As Applicant has amended claim 1 to include the original subject matter of claim 2, Applicant addresses claim 1 in this section. Likewise, claims 3, 5-7, and 10 are addressed in this section.

Applicant initially traverses the rejection because the combination is improper. The Patent Office asserts that the motivation to combine Rajakarunanayake and Finley is to provide configuration information to equipment in a location that may require such a service. This motivation is non-compelling. Rajakarunanayake is concerned with providing configuration information to routers and bridges that act as customer premises equipment (CPE). There is no indication that Finley's fueling environment has any CPE that may require such a service. Since there is no need for the service, there is no need for the combination. Since there is no need for the combination, the combination is improper, and the claims are allowable.

Even if the motivation is compelling, a point which Applicant does not concede, the Patent Office has not provided any evidence to support the motivation as required by the Federal Circuit per *Dembiczak*. Thus, since the motivation lacks evidence, the combination is improper. Since the combination is improper, the rejection is improper, and claims 1-7, 10, 11, and 30-38 are allowable.

Applicant notes that claim 4 has a different motivation asserted. The motivation to combine the references in the Patent Office's analysis of claim 4 is "to gain the advantage of providing diagnostics/upgrading capability for multiple devices . . . through a single interface." Strictly speaking, this motivation is already satisfied by Rajakarunanayake alone. That is, Rajakarunanayake is designed to work on multiple routers and other sorts of CPE, and thus provides the configuration information to multiple devices through a single interface. Since Rajakarunanayake satisfies the motivation, there is no reason to combine Rajakarunanayake with Finley. Since there is no reason to combine Rajakarunanayake with Finley, the combination is improper, and claim 4 is allowable. Even if the motivation is compelling, a point which Applicant does not concede, the motivation still lacks any actual evidence to support the motivation as required by the Federal Circuit per *Dembiczak*. Since the motivation lacks the evidentiary support required, the combination is improper. Since the combination is improper for this reason, claim 4 is likewise allowable for this reason.

Amended claim 2 deserves special mention. As amended, claim 2 recites that the software upgrade constitutes an executable program. This recitation represents an ordinary

definition for "software" as evidenced by the definitions of "software" and "program" from The Dictionary of Communications Technology, copyright 1998, attached as Exhibit A. In contrast, Rajakarunanayake does not teach or suggest such executable software, because Rajakarunanayake's software is configuration information which includes instructions on how to set an IP address for the router and the like (see Rajakarunanayake, col. 1, ll. 53-67), but is not an executable program that is loaded onto the CPE. Thus, even if the combination is proper, the combination does not teach or suggest this sort of software being uploaded from the portable computing device to the site controller or fuel dispenser as recited in the claims. To this extent, claim 4 is separately patentable.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunanayaka & Muller

Claims 8, 9, 17-20, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunanayake as applied to claim 1, and further in view of Nathan J. Muller, "Focus on OpenView: A Guide to Hewlett-Packard's Network and Systems Management Platform," (hereinafter "Muller"). Applicant respectfully traverses. The standard for patentability has been set forth above.

Applicant initially traverses the rejection because the motivation is not properly supported with actual evidence as required by the Federal Circuit per *Dembiczak*. Specifically, the Patent Office asserts that the motivation to combine Rajakarunanayake and Muller is "to facilitate compliance with software licensing agreements." This motivation lacks any evidentiary support and thus is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, claims 8, 9, 17-20, and 23 are allowable.

Claim 19 has a slightly different motivation, but the motivation remains unsupported. Specifically, the Patent Office opines that the motivation is "to ensure that contractors are paid for work they perform." This motivation lacks evidentiary support, and appears to come from Applicant's disclosure. Applicant's disclosure is not an appropriate source to derive a motivation to combine references, and amounts to impermissible hindsight reconstruction. Thus, this motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, claim 19 is allowable.

Applicant further traverses the rejection because the combination of Rajakarunanayake and Muller does not show the claim elements. Rajakarunanayake does not contemplate a fueling

environment. Nothing in Muller cures this deficiency. Thus, in combination, the two references do not teach or suggest the recited fueling environment of the independent claims. Since the combination of elements does not teach or suggest a claim element, the combination does not establish obviousness for the claims.

Applicant still further traverses the rejection because Muller does not teach the element for which Muller is cited. Specifically, claims 8 and 9 discuss accounting for the upgrades and royalties due a third party based on upgrades. The Patent Office opines that because Muller teaches "license conformance," that someone of ordinary skill in the art would recognize that license conformance includes accounting for royalties due for software installed. This recognition is not supported by the evidence in the record. "License conformance" does not necessarily indicate accounting activity, but rather could be a comparison of the number of licenses to the number of installations independent of how the licenses are acquired. Absent proof that "license conformance" implies to someone of ordinary skill in the art the accounting recited in the claims, the combination does not teach or suggest this claim element, and claims 8 and 9 are allowable for this reason as well.

Claim 17 likewise recites "determination of payment obligations." The Patent Office relies on the same unsupported interpretation of "license conformance" to support the rejection. As explained above, "license conformance" does not inherently indicate accounting or payment concerns to someone of ordinary skill in the art. To this extent, the combination does not show the claim element. Since the combination does not show the claim element, the Patent Office has not established obviousness, and claims 17-20 and 23 are allowable for this reason as well.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunanayake, Muller & Finley

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunanayake and Muller, as applied to claim 17, and further in view of Finley. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant has amended claim 17 to include the subject matter of original claim 21, and so addresses the rejection of claim 21 as if it applied to the amended claim 17.

Applicant initially traverses the combination of Rajakarunanayake and Muller for the reasons set forth above. The Patent Office does not separately address the combination of

Rajakarunananayake and Muller, and thus the combination is improper as previously explained. Since this combination is improper, the rejection is improper, and the claim is allowable.

Applicant further traverses the combination of Rajakarunananayake and Finley. The Patent Office relies on the same motivation addressed above. Specifically, the Patent Office opines that the motivation is "to provide configuration information to equipment in a location that may require such a service." Applicant has addressed this improper motivation above. Since the motivation is improper, the combination is improper, and the claim is allowable for this reason as well.

Amended claim 21 recites a particular definition for software upgrade and where the upgrade occurs. As explained above with respect to amended claim 2, the configuration information of Rajakarunananayake is not an executable program as recited in the amended claim. To this extent, the combination does not show a claim element, and amended claim 21 is allowable.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunananayake, Muller & Eastvold

Claims 22 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunananayake and Muller, as applied to claim 17, and further in view of Eastvold et al. (hereinafter "Eastvold"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection because the combination of Rajakarunananayake and Muller is improper as explained above. The Patent Office provides no new analysis as to why the references are properly combinable. Since the combination of Rajakarunananayake and Muller is improper, the rejection is improper, and the claims are allowable.

Applicant further traverses the rejection because the Patent Office has not properly combined Eastvold into the combination. The Patent Office opines that the motivation to combine Rajakarunananayake and Eastvold is "to provide more complete diagnostics information and provide tracking information for software upgrades performed." This assertion is not supported with the actual evidence required by the Federal Circuit per *Dembiczak*. That is, there is no indication that additional diagnostics are required for Rajakarunananayake's routers, and as such, there is no need to combine Rajakarunananayake and Eastvold. Since there is no need to

combine the references, the combination is improper. Since the combination is improper, the claims are allowable.

Applicant still further traverses the rejection because the combination does not establish obviousness. Claim 17 from which claims 22 and 24 depend recites a fueling environment. Rajakarunananayake, Muller, and Eastvold in combination do not show a fueling environment. Since the combination does not show a claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claims are allowable.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunananayake, Muller, Finley & ISC

Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunananayake, Muller, and Finley, as applied to claim 21, and further in view of “Re: Online Manual needed (was Re: ISC vs SCO UNIZ review),” (hereinafter “ISC”). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection of claims 25 and 26 for all the reasons set forth above for the rejection of claim 21. Applicant further traverses the rejection because the Patent Office has not supported the motivation with the actual evidence required by the Federal Circuit per *Dembiczak*. The Patent Office opines that the motivation is “to promote customer satisfaction with a software product by fulfilling warranty contracts while promoting profitability for a business by collecting fees for other upgrades.” There is no evidence that fulfilling warranty contracts promotes customer satisfaction, nor is there any evidence that collecting fees for other upgrades promotes profitability. To this extent the motivation is not proper. Since the motivation is not proper, the combination is not proper. Since the combination is not proper, the rejection is not proper, and claims 25 and 26 are allowable.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunananayake & Meyer

Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunananayake in view of Meyer et al. (hereinafter “Meyer”). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection because the Patent Office has not provided any motivation to combine the references, nor any actual evidence to support the motivation to combine the references. Specifically, the Patent Office opines that it would be obvious to

modify Rajakarunananayake to include polling in view of the teachings of Meyer, but there is no motivation as to why this would be obvious. To this extent, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, claim 27 is allowable.

Applicant further traverses the rejection because the combination of Rajakarunananayake and Meyer does not establish obviousness. Claim 27, as amended, recites that the remote location is a remote fueling location. Nothing in Rajakarunananayake teaches a fueling location. Likewise, Meyer does not teach or suggest a fueling location. Since the references individually do not teach or suggest a fueling location, the combination of references cannot teach or suggest a fueling location. Since the combination does not teach or suggest a claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claim is allowable.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunananayake, Meyer & Muller

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunananayake and Meyer, as applied to claim 27, and further in view of Muller. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection of claim 28 for all the reasons set forth above for claim 27. Applicant further traverses the rejection of claim 28 because the motivation to combine the references with Muller is not properly supported. The Patent Office asserts that the motivation is “to facilitate compliance with software licensing agreements.” However, this motivation lacks the actual evidence required by the Federal Circuit per *Dembiczak*. Since the Patent Office has not provided the actual evidence, the motivation is improper. Since the motivation is improper, the combination is improper, and claim 28 is allowable.

Applicant still further traverses the rejection because the Patent Office reads additional teachings into “license conformance.” As explained above, “license conformance” does not necessarily indicate accounting for royalties and the like, and thus, the reference does not teach the element for which it is cited. Since the reference does not teach the element for which it is cited, the combination does not teach the element. Since the combination does not teach or suggest the element, the combination does not establish obviousness. Since the combination does not establish obviousness, claim 28 is allowable.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunanayake, Meyer & FOLDOC

Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunanayake and Meyer, as applied to claim 27, and further in view of “patch from FOLDOC,” (hereinafter “FOLDOC”). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection of claim 29 for all the reasons set forth above for claim 27. Applicant further traverses the rejection because the motivation to combine the references with FOLDOC is not properly supported. The Patent Office asserts the motivation to combine the references is “to provide more efficient software upgrading by only updating those portions of code that need to be updated.” There is no evidence to support this motivation. Since the motivation is not properly supported, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and claim 29 is allowable.

Rejection Under 35 U.S.C. § 103(a) – Rajakarunanayake, Finley & Meyer

Claims 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajakarunanayake in view of Finley and Meyer. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the combination of Rajakarunanayake and Finley as lacking evidence to support the motivation to combine the references. Specifically, the Patent Office opines that the motivation to combine Rajakarunanayake and Finley is “to provide configuration information to equipment in a location that may require such service.” As explained above, this motivation is non-compelling and lacks the requisite evidentiary support. Since the motivation is non-compelling and lacks evidentiary support, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

Applicant further traverses the combination of the references with Meyer. The Patent Office does not provide a motivation to combine the references with Meyer, much less support such a motivation with evidence, as required by the Federal Circuit per *Dembiczak*. To this

extent, the combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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